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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,673	07/16/2004	Satoshi Ohtsuka	2004-1069A	2287

513 7590 02/27/2007

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EXAMINER	
MCNELIS, KATHLEEN A	
ART UNIT	**PAPER NUMBER**
1742	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/501,673	OHTSUKA ET AL.	
	Examiner	Art Unit	
	Kathleen A. McNelis	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 2 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 2 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claims Status

Claim 2 remains for examination.

Status of Previous Rejections

The previous rejection of claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuda et al. (U.S. Pat. No. 4,963,200) in view of www.novantchemcials.com is maintained.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuda et al. (U.S. Pat. No. 4,963,200) in view of www.novantchemcials.com.

Okuda et al. in view of www.novantchemcials.com is applied as set forth in the 08/22/2006 Office action.

Response to Arguments

Applicant's arguments filed 11/22/2007 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

1. Okuda et al. discloses normalization followed by tempering as opposed to heating to and holding at a temperature of not less than the Ac3 transformation point and slow cooling at a rate of not more than a ferrite forming critical rate, therefore Okuda et al. does not disclose the claimed heat treatment.
2. Applicant adds Fe_2O_3 powder to raw material powder mixed by mechanical alloying increasing the oxygen content so that the oxygen will combine with Ti, preventing formation of TiC, which is not disclosed by Okuda et al. The article on Novant Trionix

discloses a coating material and does not suggest adding Trionix as a raw material to alloys. Further, the article on Novant Trionix is in a different technical field therefore there is no motive to combine the teaching. It is not in the applicants' field of endeavor or reasonably pertinent to the particular problem with which the inventor was concerned.

Examiner's responses are as follows:

1. Although Okuda et al. does not recite heating to not less than the Ac3 transformation, such is understood by the use of the term normalizing (see Metals Handbook, Desk Edition, 2nd Edition definition of normalizing). Further, heating is to between 950 to 1200 °C (col. 6 line 67-col. 7 line 1). Since the steel composition disclosed by Okuda et al. is essentially the same as that of the instant invention, the properties (including Ac3 transformation temperature) are expected to be the same (see M.P.E.P. 2112.01 II). The instant specification discloses the Ac3 transformation at about 900 to 1200 °C (p. 10). The recitation in claim 2 of "slow cooling at a rate of not more than a ferrite-forming critical rate" does not limit the cooling rate either quantitatively (e.g. no more than X °C per hour) or to a specific cooling method (e.g. furnace cooling). Normalizing heat treatment is understood in the art to include air cooling (see Metals Handbook, p. 41), which lacking further limitations can be considered "slow cooling" (i.e. relative to quenching). Although the instant specification discloses furnace cooling at rates of not more than 100 °C/hr (p. 10) or 37 °C/hr (p. 15), limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. Examiner acknowledges that Okuda et al. does not disclose the addition of Fe_2O_3, and has relied on the teaching of Novant Trionix as reason for such addition. Corrosion resistance is desired in Okuda et al. as evidenced by required compatibility (col. 1 lines 11-17) and required chromium addition (col. 4 lines 11-18). Novant Trionix is therefore reasonably pertinent to the particular problem (i.e. corrosion) with which the inventor was concerned, and was combined for this reason as stated on p. 3 of the 08/22/2006 Office action. Although this is not same reason applicant has combined Fe_2O_3, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen A. McNelis whose telephone number is 571 272 3554. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAM
02/22/2007

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